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In re Application of BLACKBURN
U.S. Application No.: 10/526,838
PCT Application No.: PCT/AU03/01096
Int. Filing Date: 27 August 2003
Priority Date Claimed: 03 September 2002
Attorney Docket No.: 75390-010100
For: LATCH ASSEMBLY WITH DEAD LATCH
INDICATOR

DECISION

This is in response to applicant's "Renewed Petition Under 37 C.F.R. § 1.47(b) and Petition Under 37 C.F.R. § 1.183" filed 27 November 2006.

BACKGROUND

On 27 August 2003, applicant filed international application PCT/AU03/01096, which claimed priority of an earlier Australia application filed 03 September 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 18 March 2004. The thirty-month period for paying the basic national fee in the United States expired on 03 March 2005.

On 03 March 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 08 September 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 10 April 2006, applicant filed a petition under 37 CFR 1.47(b).

On 09 May 2006, this Office mailed a decision dismissing the 10 April 2006 petition.

On 06 July 2006, applicant filed a renewed petition under 37 CFR 1.47(b).

On 25 July 2006, this Office mailed a decision dismissing the 06 July 2006 petition.

On 27 November 2006, applicant filed the present renewed petition under 37 CFR 1.47(b) and a petition under 37 CFR 1.183.

DISCUSSION

I. Renewed Petition Under 37 CFR 1.47(b)

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Petitioner has previously satisfied items (1), (2), (3), (5), and (6) above.

With regard to item (4) above, the declaration submitted with the petition is improper. Specifically, the declaration fails to state the name and citizenship of the inventor as required by 37 CFR 1.497(a)(3). Applicant has submitted a petition under 37 CFR 1.183 with regard to the citizenship requirement but has not supplied any explanation as to why the name of the inventor is not stated on the declaration.

II. Petition Under 37 CFR 1.183

The petition states that "extraordinary efforts have been made to both locate inventor and determine his citizenship." However, since the citizenship of the inventor is listed in the published international application and presumably the Request (Form PCT/RO/101) filed by applicant, it is not clear why extraordinary effort would be necessary to determine the citizenship of the inventor.

37 CFR 1.183 states,

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

In the present case, applicant seeks a waiver of the requirement that the citizenship of the inventor be listed on the declaration. Listing of the citizenship of the inventor on an

oath/declaration is a requirement of the statutes. See 35 U.S.C. 115 (stating, "The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. . . .") Thus, the Director lacks authority to waive such statutory requirement. The requisite \$400.00 petition fee will be charged to Deposit Account No. 50-2638 as authorized in the petition.

CONCLUSION

For the reasons set forth in §I above, the renewed petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

For the reasons set forth in §II above, the petition under 37 CFR 1.183 is DISMISSED without prejudice.

If reconsideration on the merits of the petitions is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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